



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,314	01/31/2002	William J. Boyle	ACS- 57081	9807
24201	7590	12/30/2005	EXAMINER	
FULWIDER PATTON 6060 CENTER DRIVE 10TH FLOOR LOS ANGELES, CA 90045			TRUONG, KEVIN THAO	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,314

Applicant(s)

BOYLE ET AL.

Examiner

Kevin T. Truong

Art Unit

3731

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE and Ament. 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 29-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 29-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2005 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

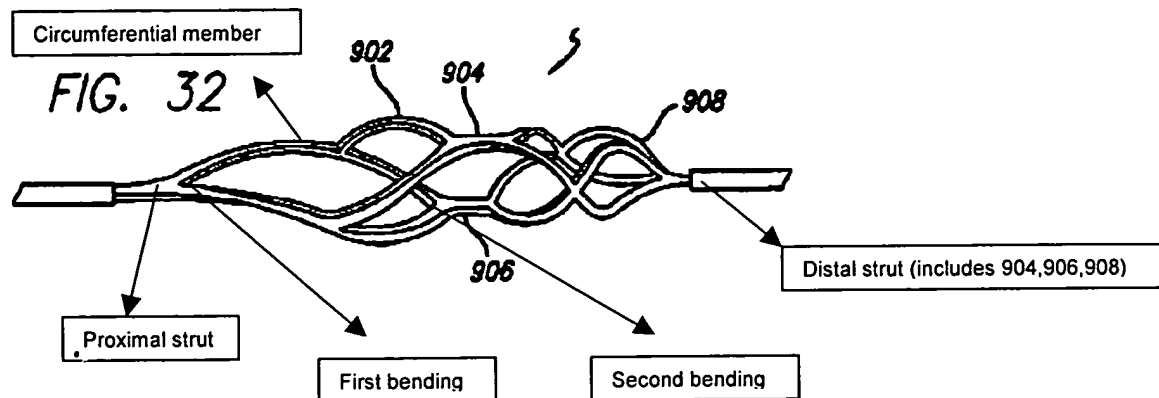
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-8 and 48 are rejected under 35 U.S.C. 102(e) as anticipated by Palmer et al (6,660,021).

As to claims 1, 3, and 4, Palmer et al discloses the claimed invention as show in figure 32 (below).

Art Unit: 3731



As to claims 2, 6-8 and 48, wherein Palmer et al. in figures 26 and 29-32, the proximal strut is adapted to be rotatably and slidably mounted on a guide wire or elongated member (604,702) (col. 17, lines 50-59 and col. 18, lines 25-29) and distal strut connected to an obturator (610,712) and furthermore, wherein the circumferential member is capable of being adapted to sealingly contact the body vessel when placed in the expanded position to form a single inlet opening for capturing debris.

1. Claims 37-38, 42-44, 50, and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniel et al. (U.S. 6,245,089).

Daniel et al discloses in figure 21B, a filter assembly (352) having an expandable cage (344), wherein said cage (344) including a circumferential member (354) which forms an inlet opening (at 356); a guidewire (346) extending through the inlet opening (at 356) of the circumferential member (354); and means or proximal strut (358,360) for maintaining the guidewire (346) substantially centered through the circumferential member (354) when the cage is placed in the expanded position. As to claims 50 and 51, wherein the circumferential member is capable of being adapted to sealingly contact the body vessel when

placed in the expanded position to form a single inlet opening for capturing debris.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 29-41, 45-47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al (6,660,021) in view of Daniel et al. (U.S. 6,245,089).

Palmer et al discloses the claimed invention except for a guidewire (604) extends through the inlet opening of the circumferential member. However, Daniel et al teaches in figure 21B, that it is known in the surgical art to have guidewire (346) extends through the inlet opening of the circumferential member (354).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Palmer et al guidewire which it would extend through the inlet opening of the circumferential member as taught by Daniel et al to provide some additional structural integrity to the circumferential member, but still allows circumferential member to float about the guidewire.

Response to Arguments

3. Applicant's arguments filed 10/31/2005 have been fully considered but they are not persuasive. With respect to claim 1, Applicant argues that Palmer patent fails to show a distal strut attached to the circumferential member at the second bending region

which has a free end positioned substantially near the longitudinal axis extending through the center of the circumferential member when placed in the expanded position. It is noted that the distal strut (including **904,906,908**) which attached to the circumferential member at the second bending region which has a free end positioned **substantially** near the longitudinal axis extending through the center of the circumferential member when placed in the expanded position, this structure is shown in the above of figure 32. With respect claims 37 and 42, Applicant argues that Daniel et al tails (358,360) do not help to center the guide wire (346) relative to frame portion (356). This is simple not convincing due to the tails (358,360) are attached to wire (346) at attachment region (362) by soldering, welding or brazing adhesive (col. 15, lines 38-41). Therefore, it would maintain the wire (346) **substantially** centered the frame portion (356) when the frame portion is in the expanded position. As to claims 29 and 37, applicant argues that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Palmer et al discloses the claimed invention except for a guidewire (604) extends through the inlet opening of the circumferential member. However, Daniel et al teaches in figure 21B, that it is know in the surgical art to have guidewire (346) extends through the inlet opening of the

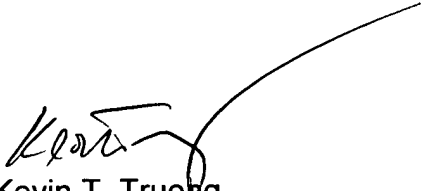
Art Unit: 3731

circumferential member (354). At least for this reason, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the Palmer patent in view of the Daniel patent as recited in the above statement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin T. Truong whose telephone number is 571-272-4705. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:00 PM..

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin T. Truong
Primary Examiner
Art Unit 3731

ktt